

REMARKS

IDS

The Examiner indicates that the IDS filed on November 6, 2003 has not yet been received. Accordingly, Applicant provides a copy of that IDS.

Claim Amendments

In addition to the amendments discussed below, Applicant amends certain claims to correct minor errors and to more clearly define the claimed subject matter.

Section 102 rejection of claims 1 and 38

As best understood, the Examiner considers the word “groove” to mean, among other things, include a tube. It is for this reason that the Examiner considers the optical fibers 19 passing through the tubes in FIG. 2 of *Davies*¹ to occupy “grooves.”

In response, Applicant requests entry of an amendment to claims 1 and 38. The proposed amendment recites “open grooves” instead of simply “grooves.” The resultant claims distinguish over *Davies* because, to the extent that the tubes in *Davies* can be called “grooves,” those “grooves” are enclosed. Accordingly, the proposed amendment is believed to place the claims in condition for allowance.

The proposed amendment only makes explicit what is already implicit in the claim. In particular, claim 1 recites a

“housing having...grooves arranged *thereon*.”

The adverb “*thereon*” rather than, for example, “*therein*” or “*therethrough*,” was selected to connote a groove that is *on* the housing. The “enclosed grooves” (otherwise known as “tubes”) through which the optical fibers pass in *Davies* are not *on* the housing. They are *in* the housing. Applicant submits that there is a difference between the prepositions “on” and “in.”

¹ *Davies*, U.S. Patent No. 4,672,961.

The distinction between placing the fibers in *open* grooves, as recited in claim 1, and inserting them into *enclosed* grooves, as shown in *Davies*, is a distinction with a difference. For example:

(1) Inserting a fiber into an enclosed groove (i.e., a tube) is like threading a needle. One must insert the fiber by moving it in the axial direction. It is much easier to simply nestle the fiber into an open groove by moving it into the groove in a direction orthogonal to the axial direction.

(2) "Enclosed grooves (i.e., a tubes) in molded parts often result in knit lines. These knit lines can compromise accuracy of part placement and material strength. Open grooves, which are on the surface of a molded part, are unlikely to cause knit lines.

(3) Placing the fibers in open grooves permits the resulting catheter to have a smaller overall profile because there is no need to provide additional material to bury the fibers.

Applicant submits that *Davies* fails to disclose or suggest a catheter in which fibers are placed in *open* grooves as required by claim 1. Accordingly, Applicant requests withdrawal of the section 102 rejection of claim 1, and all claims dependent thereon.

Claim 38 recites similar limitations. Accordingly, Applicant also requests withdrawal of the section 102 rejection of claim 38 and all claims dependent thereon.

Section 103 rejection of claim 25

Applicant requests entry of an amendment to claim 25. The proposed amendment includes the limitation of a housing with "elongated *open* grooves arranged thereon" and a fiber "in each of said elongated *open* grooves." For reasons discussed above, *Davies* fails to disclose this limitation. Hence, the proposed amendment places the claims in condition for allowance.

The additional reference *Mueller* fails to disclose this missing limitation. Therefore, the combination of *Davies* and *Mueller* cannot amount to the claimed invention because neither *Davies* nor *Mueller* disclose or suggest the missing claim limitation. Accordingly, Applicant

requests reconsideration and withdrawal of the section 103 rejection of claim 25 and all claims dependent thereon.

Dependent claims

The office action suggests that Applicant has acquiesced to the rejection of the dependent claims simply because Applicant did not "argue separately why the applied references would be non-inherent or non-obvious."

In the previous response, Applicant argued that the rejection of the dependent claims was improper because the rejection of their respective parent claims was improper. In doing so, Applicant does not mean to imply that there exist no other grounds for asserting that the dependent claims are allowable. A response to an office action is not required to be an exhaustive catalog of every possible ground for distinguishing each and every claim.

Applicant also points out that simply because only one argument has thus far been advanced in support of the allowability of the independent claims does not mean that there exist no other arguments.

Summary

Now pending in this application are claims 1-42, of which claims 1, 25, and 38 are independent. No additional fees are believed to be due in connection with the filing of this response. However, to the extent fees are due, please adjust our deposit account 06-1050,

Respectfully submitted,

Date: Oct 13, 2008



Faustino A. Lichauco
Reg. No. 41,942

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906
20952551.doc